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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,028	01/29/2002	Tokuju Oikawa	2870-0179P	2676

2292 7590 12/04/2002

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EXAMINER
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CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

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DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/058,028

Applicant(s)

OIKAWA, TOKUJU

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ito et al (Ito) or JP11-149136 (JP'146) in view of JP11-194447 (JP'447), Eshelman et al (Eshelman), Lok et al ('112), and Lok et al ('270).

Ito a photothermographic material containing non-photosensitive silver halide, photosensitive silver halide, reducing agent for silver ions and binder and the compound of formula (1) to (3) claimed in the present claimed invention, and the amount thereof is within  $1 \times 10^{-6}$  mol to 1 mol/mol of silver halide. Note to the compound of formula (1) to (3) in column 18 and the amount thereof in column 33, lines 22-25. The photosensitive silver halide having grain size of 0.02 to 0.12  $\mu\text{m}$  and chemically sensitize with gold compound. Note column 9, lines 45-55 and column 12, lines 16-29. See also the teaching of the process in column 90, lines 41-67 and columns 91-92.

The JP'136 discloses a heat-developable material containing non-photosensitive silver halide, photosensitive silver halide, reducing agent for silver ions and binder and the compound exemplified in the present application disclosure which meet the requirements (1) to (iii) claimed in the present invention, and the amount thereof is from  $1 \times 10^{-6}$  mol to 1 mole/mol of silver halide. See the compound in column 1 (or Its English

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equivalent , US Patent No. 6,177,240, in columns 7-24; and in column 26, lines 37-40). 29 and the English equivalence of JP'146, Yamada et al, in column 30, line 45. The photosensitive silver halide having grain size of 0.02 to 0.14  $\mu\text{m}$  and chemically sensitize with gold compound. Note to the English Equivalence thereof in column 29, lines 42-55, and column 30, line 45. See also the process such as exposing the material with laser in column 44.

The teaching in Ito and JP'136 differs from the claimed invention in the use of the organic gold compound to chemically sensitize the silver halide emulsion, which has been however known in the art such as disclosed in JP11-194447 (JP'447), Eshelman , Lok et al ('112) or '270. It would have been obvious to use a known organic gold sensitizer to chemically sensitize the silver halide emulsion taught in Ito or JP'136 to provide the invention as claimed.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Ito et al (Ito) or JP11-149136 (JP'146) in view of JP11-194447 (JP'447), Eshelman et al (Eshelman), Lok et al ('112), and Lok et al ('270) as applied to claims 1-8, 10-12 above, and further in view of Hahm et al (Hahm).

Hahm discloses the sulfur compound of claim 9 in combination with gold compound to chemically sensitize silver halide emulsion. See the abstract of the invention. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the sulfur compound in combination with the gold sensitizer to chemically sensitize the silver halide taught in Ito or JP'136 to provide invention as claimed.

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The data shown in the specification disclosure has been considered, but does not overcome the rejection set forth above since it is irrelevant to Ito or JP'136. Moreover, the results shown therein is similar to that taught in Ito and JP'136 in term of Dmax .

### ***Conclusion***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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Tchea   
December 1, 2002

  
Thorl Chea  
Primary Examiner  
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